

REMARKS

Claims 68-83 are now pending. Claims 68 and 77 are independent. Claim 77 has been amended to define more clearly what Applicants regard as their invention.

In the Office Action, claims 68-83 were rejected under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 5,533,097 (*Crane*). Applicants respectfully traverse those rejections for two completely independent reasons, as explained below.

Reason 1: The Components in *Crane* Are Not All Housed in the Same Housing.

Claim 68 is directed to a portable apparatus that includes: a portable hand-held housing; a data processing unit housed by the housing and configured to run application software; a display housed by the housing and operably connected to the data processing unit; at least one user interface device housed by the housing and operably connected to the data processing unit; at least one memory housed by the housing and operably connected to the data processing unit for storing image data and for storing data from the data processing unit; a data interface configured to input image data from a camera and route the inputted image data to the data processing unit; and a mobile telephone unit housed by the housing and configured to (a) wirelessly transmit inputted image data to a remote location, (b) wirelessly transmit speech, and (c) wirelessly transmit text.

By using the definite article “the” in the passages underlined above, claim 68 is making an antecedent reference back to the first element of the claim (i.e., “a portable hand-held housing,” which is also underlined above). Thus, in order to satisfy claim 68, the data processing

unit, display, user interface device, memory, and mobile telephone unit must all be housed in the same portable hand-held housing.

At pages 3-4, the Office Action points to the “microprocessor 301 within the briefcase 101” as satisfying the “data processing unit housed by the housing” limitation of claim 68. The Office Action also points to the “display on the notepad 107” as satisfying the “display housed by the housing” limitation of claim 68, and points to the “handset 105” as satisfying the “mobile telephone unit housed by the housing” limitation of claim 68. But it is clear from Figures 1 and 2 of *Crane* that the notepad 107 (which has the display) is in one housing, the handset 105 (i.e., the mobile telephone unit) is a second distinct housing, and the briefcase 101 that contains the microprocessor 301 is in yet a third distinct housing. Since those three components in *Crane* are not all housed in the same housing, as required by claim 68, that claim is not anticipated by *Crane*.

Claim 77 has been amended as set forth above to indicate that the display, user interface, and memory must all be “housed by the housing.” Here again, the definite article “the” makes antecedent references back to “the housing,” so all three of those components must be in the same housing, as explained above in connection with claim 68. Claim 77 is therefore not anticipated by *Crane* for the same reasons as claim 68.

Reason 2: *Crane* Does Not Disclose Selecting a Destination for an Image from a List.

The last paragraph of claim 68 recites that “the application software includes a routine that enables a user to select a destination for a wireless transmission of an image from a list of potential destinations.” Page 4 of the Office Action cites Fig. 3; col. 2 through col. 3, line 20;

and col. 4, lines 10-40 of *Crane* as satisfying this limitation, and quotes *Crane* as saying that “phone lists allowed a user to select a destination for wireless transmitted.” But the undersigned could not locate that language in the portions of *Crane* that were cited in the Office Action, and moreover could not find that language anywhere else in *Crane*.

As understood by the undersigned, col. 5, lines 53-62 is the only part of *Crane* that discusses making selections from a phone list. But that portion of *Crane* relates to selecting a destination for “a cellular phone call” from a phone list. See *Crane* at col. 5, lines 53-54 and 60-61. The undersigned was unable to locate any portion of *Crane* that relates to selecting a destination for an image transmission from such a list. Accordingly, Applicants respectfully request withdrawal of the § 102 rejection of claim 68. In the alternative, in view of the undersigned’s inability to locate the relevant portions of *Crane*, **if the rejection is not withdrawn, Applicants respectfully ask the examiner to identify which portions of *Crane* disclose “select[ing] a destination for a wireless transmission of an image from a list of potential destinations.”** See M.P.E.P. § 706.02(j) (“the examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate”).

Claim 77 contains similar limitations, and is therefore believed patentable for the same reasons as claim 68.

Conclusion

The other claims in this application each depend on one of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each

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dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

A Request for Continued Examination is submitted herewith to facilitate the filing of an Information Disclosure Statement, which will be filed shortly under separate cover in order to cite information from related litigation and reexamination proceedings.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached by telephone at (212) 969-3246. Please direct all correspondence to Customer No. 42532 at the address provided below.

Respectfully submitted,

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